

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-4 and 6-26 are pending in the application, with claims 1, 10, 13, 16, 21, and 25 being the independent claims. Claims 1-3, 10, 13, 16, 21-23, and 25 are sought to be amended for clarity. Support for these amendments is found at least at, for example, paragraphs [0021], [0057] - [0060], and [0103] of Publication No. US 2005/0223414 A1 (alternatively, "the Specification"). Claim 5 is sought to be canceled without prejudice to or disclaimer of the subject matter therein. These amendments should be entered after final because they do not require further search or consideration by the Examiner and they place the claims in condition for allowance and/or reduce the issues for appeal. Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

The Examiner is thanked for the indication on page 2 of the Office Action of the withdrawal of the previous rejections under 35 U.S.C. § 101.

Provisional Nonstatutory Double Patenting Rejections

The Examiner, on page 3 of the Office Action, has provisionally rejected claims 1-26 under the judicially created doctrine of obviousness-type double patenting for allegedly being unpatentable over claims 1-3, 9-28, and 33-36 of co-pending U.S. Patent Application No. 10/815,251. As noted by the Examiner, claims 1-26 are not identical to claims 1-3, 9-28, and 33-36 of co-pending U.S. Patent Application No. 10/815,251.

The cancellation of claim 5 renders the rejection of this claim moot.

Applicants request that the double patenting rejection be held in abeyance until prosecution of the instant application on the merits is substantially completed.

Claims 1-3, 10, 13, 16, 21-23, and 25 are amended herein. Claims 2-4 and 6-9 depend from claim 1. Claims 14, 15, and 26 depend from claim 13. Claims 17-20 and 22-24 depend from claims 16 and 21, respectively. Applicants submit that the pending method claims 1-4 and 6-20 of the instant Application are patentably distinct from claims 1-3, 9-28, and 33-36 of co-pending U.S. Patent Application No. 10/815,251. Applicants further submit that the pending computer readable medium and system claims 21-25 are patentably distinct from claims 1-3, 9-28, and 33-36 of co-pending U.S. Patent Application No. 10/815,251.

On page 4 of the Office Action, claims 1-26 were provisionally rejected under the doctrine of obviousness-type double patenting over co-pending U.S. Patent Application No. 10/676,850.

Specifically, claims 1-26 were provisionally rejected as being allegedly not being patentably distinct from claims 1-28 of co-pending Application No. 10/676,850. As the Examiner notes in section 9 of the Office Action, claims 1-26 are not identical to claims 1-28 of co-pending Application No. 10/676,850. As noted above, claims 1-3, 10, 13, 16, 21-23, and 25 are amended herein.

Also, pursuant to M.P.E.P. § 804(I)(B), since co-pending Application No. 10/676,850 has not been allowed, the Examiner should maintain the double patenting rejection in this instant application as a 'provisional' double patenting rejection, which can be converted into a double patenting rejection when the co-pending application issues as a patent. Applicants will appropriately address the provisional double patenting

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rejection in the event it is converted to an actual double patenting rejection pursuant to M.P.E.P. § 804(I)(B) after the co-pending application issues as a patent.

Rejections under 35 U.S.C. § 112

Claims 25 and 26 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse this ground of rejection.

On page 5 of the Office Action the Examiner states, which Applicants do not acquiesce to, that “the claims recite the limitations such as “computer-readable storage medium configured to store a plurality of cryptographic key pairs” were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” (Office Action, page 5) (emphasis in original). As noted by the Examiner , Applicants' specification provides support for key storage. Applicants have amended claim 25 to accommodate the rejection of the Examiner merely in order to expedite prosecution without conceding the propriety of the rejection. Support for this amendment is found in the specification, at least at, for example, paragraphs [0021] and [0103], which recite, in part:

As a computer readable medium including at least computer program code for providing automated document retention for electronic documents, one embodiment of the invention includes at least: computer program code for obtaining an electronic document; computer program code for assigning a document retention policy to the electronic document, the document retention policy being based on a recurring cut-off retention schedule; and computer program code for cryptographically imposing the document retention policy on the electronic document.

And:

The invention can also be embodied as computer readable code on a computer readable medium. The computer readable medium is any data storage device that can store data which can thereafter be read by a computer system.

Rejections under 35 U.S.C. § 102

Claims 1-26 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Application Publication No. 2005/0071657 to Ryan ("Ryan"). With regard to the Examiner's response on pages 2 and 3 of the Office Action to Applicants' previously-submitted arguments and the statements on pages 6-16 of the Office Action, in which the Examiner continues to characterize Ryan as disclosing all of the features recited in claims 1-26, Applicants disagree and traverse for the reasons stated below.

The cancellation of claim 5 renders the rejection of this claim moot.

Anticipation under 35 U.S.C. § 102 requires showing the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. See *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Applicants submit that Ryan does not disclose at least the distinguishing features of claims 1, 10, 13, 16, 21, and 25.

Independent claims 1, 10, 13, 16, 21, and 25 recite features that distinguish over Ryan. For example, claim 1 as amended herein recites, among other features:

assigning a document retention policy to the electronic document, the document retention policy being derived from a recurring cut-off retention schedule specifying cut-off periods, each cut-off period having a respective document retention duration associated therewith and corresponding to a respective maximum off-line period of a client,

wherein the maximum off-line period expires a predetermined period of time after a beginning of its cut-off period; and
encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during retention durations and prior to the expiration of the maximum off-line period of the client.

Ryan, in the sections cited by the Examiner, or in other sections, contains no teaching or suggestion of encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during retention durations and prior to the expiration of the maximum off-line period of the client, as recited in claim 1.

While Ryan may describe a time-based access restriction that limits access to a secured electronic file "after a predetermined time in the future" (Ryan, paragraph [0037]), Ryan does not disclose a method of providing automated document retention for an electronic document with the above-noted distinguishing features of claim 1. In Ryan's system, a time-based access key is obtained after a predetermined time associated with the time-based access key has passed and that "[t]ypically, the private time-based access key is only able to be obtained if a predetermined time associated with the private time-based access key has been exceeded" (Ryan, paragraph [0051]). In contrast, claim 1 recites encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during retention durations and prior to the expiration of the maximum off-line period of the client. In contrast to what is recited in claim 1, Ryan discloses that "only a user with proper access privileges can access the secured document and then only after a time restriction, if present, is satisfied" and that "the needed cryptographic keys to unsecure a

secured electronic document are released by a server to a client only after a time restriction is satisfied" (Ryan, paragraphs [0060] and [0068]).

Therefore, for at least the above reasons, Ryan fails to disclose all features of independent claim 1. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claim 1, and find it allowable over the applied reference.

Dependent claims 2-4 and 6-9, which depend upon claim 1, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective distinguishing features. See *In Re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) and M.P.E.P. § 2143.03. Accordingly, Applicants respectfully requests this rejection be removed and that claims 1-4 and 6-9 be passed to allowance.

On page 9 of the Office Action, independent claim 10 is rejected based on similar rationale as applied to claim 1. Claim 10 recites, *inter alia*:

generating a next document retention key to be used to encrypt the electronic document during a next cut-off period, the next document retention key having a document retention duration associated therewith and corresponding to a maximum off-line period of a client, wherein the maximum off-line period expires a predetermined period of time after a beginning of the next cut-off period; and

notifying the client of the next document retention key, the electronic document being cryptographically accessible only during document retention durations and prior to the expiration of the maximum off-line period of the client using a cryptographic key associated with such durations

Applicants submit that amended claim 10 recites a method with distinguishing features similar to claim 1, and thus is patentable over the applied reference for similar reasons as discussed above with regards to claim 1.

As discussed above with regards to similar features recited in claim 1, Ryan fails to teach or suggest an electronic document being cryptographically accessible only during document retention durations and prior to the expiration of the maximum off-line period of the client using a cryptographic key associated with such durations, as recited in claim 10.

Dependent claims 11 and 12, which depend from independent claim 10, are allowable for at least being dependent from an allowable independent claim, in addition to their own respective distinguishing features. Accordingly, Applicants respectfully request this rejection be removed and that claims 10-12 be passed to allowance.

On page 11 of the Office Action, independent claim 13 is rejected based on similar rationale as applied to claim 1. Claim 13 as amended herein recites, among other features:

encrypting the document key using the retention access key to produce an encrypted document key, the retention access key being usable for said encrypting during a cut-off period of a recurring cut-off retention schedule, the cut-off period having a document retention duration associated therewith and corresponding to a maximum off-line period of a client, wherein the maximum off-line period expires a predetermined period of time after a beginning of the cut-off period; and

storing the secured electronic document, the secured electronic document being cryptographically accessible only during the document retention duration and prior to the expiration of the maximum off-line period of the client.

Applicants submit that claim 13 recites a method with distinguishing features similar to claim 1, and thus is patentable over Ryan for similar reasons as discussed above with regards to claim 1.

As discussed above with regards to similar features recited in claim 1, Ryan fails to teach or suggest a secured electronic document being cryptographically accessible

only during the document retention duration and prior to the expiration of the maximum off-line period of the client, as recited in claim 13.

On pages 12 and 13 of the Office Action, independent claim 16 is rejected based on similar rationale as applied to claims 1 and 13. Claim 16 recites, *inter alia*:

encrypting the document key using the retention access key to produce an encrypted document key, the retention access key being usable for said encrypting during a cut-off period of a recurring cut-off retention schedule, the cut-off period having a document retention duration associated therewith and corresponding to a maximum off-line period of a client, wherein the maximum off-line period expires a predetermined period of time after a beginning of the cut-off period; and

storing the secured electronic document, the secured electronic document being cryptographically accessible only during the document retention duration and prior to the expiration of the maximum off-line period of the client.

Applicants submit that amended claim 16 recites a method with distinguishing features similar to claims 1 and 13, and thus is patentable over Ryan for similar reasons as discussed above with regards to claims 1 and 13.

As discussed above with regards to similar features recited in claims 1 and 13, the applied reference fails to teach or suggest storing the secured electronic document, the, the secured electronic document being cryptographically accessible only during the document retention duration and prior to the expiration of the maximum off-line period of the client, as recited in claim 16.

Dependent claims 17-20 depend from claim 16, and are thus allowable for at least being dependent from an allowable independent claim, in addition to their own respective distinguishing features. Accordingly, Applicants respectfully request this rejection be removed and that claims 16-20 be passed to allowance.

On pages 14 and 15 claims 21 and 25 are rejected based on similar rationale as applied to claim 1. Claim 21 as amended herein recites, *inter alia*:

assigning a document retention policy to an electronic document, the document retention policy being derived from a recurring cut-off retention schedule specifying cut-off periods, each cut-off period having a respective document retention duration associated therewith and corresponding to a respective maximum off-line period of a client, wherein the maximum off-line period expires a predetermined period of time after a beginning of its cut-off period; and
encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during retention durations and prior to the expiration of the maximum off-line period of the client.

Applicants submit that amended claims 21 and 25 recite a computer-readable medium and a computer-implemented file security system, respectively with distinguishing features similar to claim 1, and thus are patentable over the applied reference for similar reasons as discussed above with regards to claim 1.

As discussed above with regards to similar features recited in claim 1, Ryan does not teach or suggest encrypting the electronic document based on the document retention policy such that the electronic document can be cryptographically accessed only during retention durations and prior to the expiration of the maximum off-line period of the client, as recited in claim 21. Similarly, as discussed above with regards to similar features recited in claim 1, the applied reference fails to teach or suggest the secured electronic document being cryptographically accessible only during the -retention durations_ and prior to the expiration of the maximum off-line period of the client, as recited in amended claim 25.

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Further, dependent claims 22-24 depend from claim 21, and are thus allowable for at least being dependent from an allowable independent claim, in addition to their own respective distinguishing features. Accordingly, Applicants respectfully request this rejection be removed and that claims 21-25 be passed to allowance.

Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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